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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/544,799	04/07/2000	Jeremy A. Levitan	1026-017/MMM127340.1	1559

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EXAMINER

SHAHER, RICKY D

ART UNIT

PAPER NUMBER

2872

DATE MAILED: 11/30/2001

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/544,799

Applicant(s)

LEVITAN

Examiner

R. O. SHAFER

Group Art Unit

2872

— The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address —

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

☒ Responsive to communication(s) filed on 8/20/01

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, **prosecution as to the merits is closed** in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

Disposition of Claims

☒ Claim(s) 1-38 is/are pending in the application.

Of the above claim(s) 5-9 AND 11-38 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-4 AND 10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claim(s) _____ are subject to restriction or election requirement

Application Papers

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119 (a)-(d)

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119 (a)-(d).

☐ All ☐ Some* ☐ None of the:

☐ Certified copies of the priority documents have been received.

☐ Certified copies of the priority documents have been received in Application No. _____

☐ Copies of the certified copies of the priority documents have been received

in this national stage application from the International Bureau (PCT Rule 17.2(a))

*Certified copies not received: _____

Attachment(s)

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☒ Notice of Reference(s) Cited, PTO-892

☐ Notice of Informal Patent Application, PTO-152

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Other _____

Office Action Summary

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1. Applicant's election with traverse of invention I (claims 2-4 and 10) in Paper No. 5 is acknowledged. The traversal is on the ground(s) that the restriction requirement improperly characterizes the relationship of some of the identified groups as combination/subcombination, based on the assertion that in order to be properly characterize as a combination, a subcombination must be combined with at least one additional element.

This is not found persuasive because the term "combination" is used to denote a whole and the term "subcombination" is used to denote any part of the disclosure or of the most comprehensive claim less than the whole. For example, the invention of group II is clearly drawn to a combination due to the fact that the invention combines at least two things/features together: (1) a substrate having first and second conductors, (2) a first conductive coil, (3) a second conductive coil (4) a magnet and (5) a bridge (ABC) or particular details of the coils (ABsp); and the invention of group III is similarly drawn to a combination due to the fact that the invention combines at least two things/features together: (1) a substrate having first and second conductors, (2) a first conductive coil, (3) a second conductive coil (4) a magnet and (5) a mirror (ABD). Thus, the invention of group I is clearly a subcombination of the invention of groups, II and III due to the fact that group I is less than a whole, wherein the invention only includes: (1) a substrate having first and second conductors, (2) a first conductive coil, and (3) a magnet with particular coil details (Bsp).

It should be clear that Inventions III (ABD) and I (Bsp) are related as combination and subcombination, respectively, and similarly the portion of Inventions II (ABC) and I (Bsp) are

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related as combination and subcombination, respectively, See M.P.E.P. 806.05(c)1. It should be also clear that the portion of Inventions II (ABsp) and I (Bsp) are related as combination and subcombination and the presence of claim 5 would be represented as (ABbr). See M.P.E.P. 806.05(c)3.

The examiner is of the opinion that the restriction requirement of Paper No. 3 clearly set forth how each of the various inventions are considered to be patentably distinct and the burden associated with the search and examination of those invention(s). Applicant may overcome the requirement for restriction by presenting an allowable linking claim or by providing clear admission on the record that the claim(s) drawn to a given non-elected invention is not patentably distinct from the elected invention.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 5-9 and 11-38 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention, the requirement having been traversed in Paper No. 5.

3. Claims 1-4 and 10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In claim 1, lines 8-9, the language "the second end is in communication with the second conductor" would appear to be misdescriptive, incomplete and/or fails to particular point out and distinctly claim the subject matter which applicant regards as the invention. As understood by the

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examiner, it would appear that the first end of the coil (218) is fixedly coupled to a substrate (206) as well as being in communication with a first conductor (224). However, it would appear that the second end of the coil would be would connected to the mirror (200) and not with a second conductor. Note Figure 19. Correction or a detail explanation is require in order for the examiner to properly facilitate the understanding of the invention.

4. Any inquiry concerning this communication should be directed to R.D. Shafer at telephone number (703) 308-4813.

RDS

November 3, 2001

R.D. Shafer
RICHARD D. SHAFER
PATENT EXAMINER
ART UNIT 2872